REMARKS

Claims 1-35 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I.   Rejection of Claims 1-3, 6, 10-12, 15, and 22-35 Under 35 U.S.C. § 102(b)

Claims 1-3, 6, 10-12, 15, and 22-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Evans *et al.* (U.S. Patent No: 5,805,899). It is submitted that this rejection be withdrawn for at least the following reasons. Evans *et al.* does not disclose or suggest each and every element set forth in the subject claims.

> For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

In particular, Evans *et al.* does not disclose or suggest providing an assembly with a manifest that contains a list of at least one module that makes up the assembly, as required by independent claims 1, 10, 22, 23, 27, and 30. In the Office Action dated January 2, 2003, the Examiner relies on ELF Object File (Fig. 5, 10) and Mapfile 132 (Fig. 2c) of Evans *et al.* as being equivalent to the assembly and manifest, respectively, of the subject claims. However, the ELF Object File illustrated in Fig. 5 merely shows an output of a link-editor of Fig. 2(a) that is included in a versioned object (col. 3, lines 36-37). The link-editor 124 of Fig. 2(a) receives input of mapfile 130 and of relocatable object code 112 for a shared object and generates an output of shared object 114. Mapfile 130 specifies *global symbols and a version name* for each version of the shared object. (col. 4, line 65-col. 5, line 2). Likewise, the ELF Object File illustrated in Fig. 10 merely shows an output of the link editor of Fig. 2(b) that is included in a dynamical executable application program (col. 3, lines 46-48); and mapfile 132 is utilized to indicate which *versions* of shared object 114 are allowed in the link. Thus, mapfiles 130

and 132 do not contain a list of at least one module that makes up the ELF Object File. Rather, the mapfiles 130 and 132 only include version information. A version, as stated in the 'Summary of the Invention' section of Evans *et al.* "is a name or label recorded in an object" (col. 2, line 18). In contrast, modules include routines, programs, components, data structures, etc. that perform particular tasks or implement particular abstract data types (p. 9, lines 5-6).

Moreover, Evans *et al.* does not disclose or suggest providing the manifest with a hash of the contents of at least one module of the list of modules, as recited in claims 1, 10, 22, 23, 27, and 30. Instead, Evans *et al.* discloses a hash value 614, which is merely a hash value to the name of a structure version. Further, hash value 614 is located in a version definition section 506 of versioned shared object 114; not in mapfiles 130 and 132, which the Examiner relied on earlier as being equivalent to the manifest. The Examiner cannot rely on two different elements of Evans *et al.* (*e.g.*, mapfiles 130 and 132 and version definition section 506) as being equivalent to one element (*e.g.*, manifest) of the subject claims.

Thus, because Evans *et al.* does not disclose each and every element as set forth in claims 1, 10, 22, 23, 27, and 30, Evans *et al.* does not anticipate such claims. Claims 2-9 depend from claim 1; claims 11-17 depend from claim 10; claims 24-26 depend from claim 23; claims 28-29 depend from claim 27; and claims 31-35 depend from claim 30. Accordingly, withdrawal of this rejection and allowance of claims 1-7 and 22-35 are respectfully requested.

II.   Rejection of Claims 4, 5, 7-9, 13, 14, and 16-21 Under 35 U.S.C. § 103(a)

Claims 4, 5, 7-9, 13, 14, and 16-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans *et al.* (U.S. Patent No: 5,805,899), in view of Rohatgi *et al.* (U.S. Patent No: 5,625,693). It is submitted that this rejection be withdrawn for at least the following reasons. The combination of Evans *et al.* and Rohatgi *et al.* does not teach or suggest every limitation set forth in the subject claims.

> To reject claims in an application under §103, an examiner
> must establish a *prima facie* case of obviousness. A *prima*

facie case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations.* *See* MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure. See In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Regarding independent claim 18, Evans *et al.* does not teach or suggest an assembly including a manifest that contains a list of modules that make up the assembly, as discussed above with respect to independent claims 1, 10, 22, 23, 27, and 30. It is respectfully submitted that Rohatgi *et al.* does not make up for the aforementioned deficiencies of Evans *et al.* Rohatgi *et al.* simply describes employing hash data to ensure that data accepted by an interactive television system is authorized data.

Further, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Teachings of references can be combined *only* if there is some suggestion or incentive to do so. Here, neither the nature of the problem to be solved, the teachings in the cited art, nor the knowledge of persons of ordinary skill provide sufficient suggestion or motivation to combine the references. Instead, the Examiner relies on improper hindsight in reaching his obviousness determination. The Federal Court has held that to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) (citations omitted). Evans *et al.* and Rohatgi *et al.* cannot be combined to make the

present invention obvious because there is not proper suggestion or motivation to combine the references teachings to create the subject matter of claim 18. Evans *et al.* is directed to providing versioning information for a plurality of software objects; while Rohatgi *et al.* is directed to ensuring that data accepted by an interactive television system is authorized data.

In the Office Action dated January 2, 2003, the Examiner stated that "it would have been obvious for one of ordinary skill in the art at the time the invention was made to include hashing the contents of the container of the list of objects into a secure entity as taught by Rohatgi to the establishing of linking lists of versioned objects taught by Evans." The Examiner further stated that combining Evans *et al.* and Rohatgi *et al.* "would impart additional trustworthiness ... to the version checking process as taught by Evans as more security is applied to the each instance containing/assembling those versioned objects." Rohatgi *et al.* teaches the importance of security to mitigate invasion and intentional infliction of damage of an interactive television system by unauthorized users, which problems do not exist in Evans *et al.* Moreover, Evans *et al.* does not mention any problem of security with regard to checking version information. Accordingly, it appears that the purported combination of Evans *et al.* and Rohatgi *et al.* is based on improper hindsight, using the claims of the present invention as a guide.

In view of at least the aforementioned reasons, the subject invention as recited in claim 18 is not obvious over Evans *et al.* and Rohatgi *et al.* taken individually or in combination. Claims 19-21 depend from claim 18. Moreover, claims 4-5, 7-9, 13-14, and 16-17, depend from claims 1 and 10, which are believed to be allowable for at least the reasons discussed in Section I, above. Therefore, claims 4-5, 7-9, 13-14, and 16-17 are not obvious over the combination of Evans *et al.* and Rohatgi *et al.* Withdrawal of this rejection and allowance of claims 4, 5, 7-9, 13, 14, and 16-21 are respectfully requested.

III.   **Conclusion**

The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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